

REMARKS

In this reissue application, original patent claims 1-17 were previously cancelled. New claims 18-26 were previously added, after which claims 20-26 were cancelled.

Claims 18-19 were pending and stand rejected. New claim 27 is added herein. Claims 18-19 and 27 are pending upon entry of this amendment.

Claims 18-19

Claims 18-19 are rejected under 35 USC 251 as being a) based upon a defective reissue declaration and b) broadened claims filed after the two-year statutory period (Detailed Action, page 2).

The Board of Patent Appeals and Interferences (BPAI) affirmed this rejection in its opinion dated August 30, 2010. A BPAI opinion affirming a similar rejection in a different application is currently on appeal in the Court of Appeals for the Federal Circuit (Docket No. 2010-1443; Application Serial No. 11/503,541).

Regarding the rejection, consideration of the arguments that were made in the first Reply Brief (filed October 15, 2008) and the second Reply Brief (filed January 12, 2009) is requested. These arguments are copied herein for the examiner's convenience.

First Reply Brief (filed October 15, 2008)

The legal issue to be decided in this matter is whether the examiner has correctly required that, in a continuation of a broadening reissue, "the newly broadened claims should be broadened in a way that is covered under the original reissue declaration filed in the reissue parent which was filed within two years of issue of the original patent issuance." (Examiner's Answer, page

4.) In fact, there is no such requirement in the law. The only support that the examiner has offered for his position was: (1) a citation to *In re Doll*, 419 F.2d 925, 164 U.S.P.Q. 218 (CCPA 1970); and (2) a discussion of public policy. But neither of these supports the examiner's enhanced requirement for reissue declarations.

In the Examiner's Answer, the examiner makes much of the fact that *Doll* discusses whether the "original" reissue oath/declaration was adequate to support the later-filed claims. But the court in *Doll* was merely addressing whether the declaration was adequate, after dealing with the primary issue about whether claims may be broadened outside the scope of the original declaration. *Doll*, 419 F.2d at 928. The court was in no way suggesting any additional requirement that later-filed claims must be supported by an original declaration, as the examiner implies.

Furthermore, the Examiner's Answer completely ignores the fact that *Doll* already considered — and soundly rejected — the same policy arguments that the examiner has advanced to support his rejection in this case. The *Doll* court explained:

The solicitor further makes reference to rights of the public. We have considered that argument but believe it unnecessary to comment thereon in detail in view of our interpretation of section 251 except to note, as does appellant, that 35 U.S.C. 252 provides safeguards for the public by virtue of its intervening rights provisions.

Id. One could not follow *Doll* and yet still be persuaded by the examiner's arguments based on public notice. *Doll*'s rejection of the same arguments that the examiner has made here demonstrates that the examiner misinterpreted and misapplied that case.

Finally, the examiner has attempted to distinguish *Doll* on the ground that the broadened claims in *Doll* were presented after two years in the first reissue application, whereas in this case the broadened claims were presented in a continuation application. This is a distinction without a difference, and the examiner has provided no explanation for why the distinction would be

meaningful. In both cases the public would not have been on notice of the scope of the broadened claims until after the two-year period, and in both cases the public would be on notice of the intent to broaden within that period. Accordingly, the examiner's policy arguments would apply equally to this case as they would in *Doll*. But as noted above, the court in *Doll* has already considered and rejected those arguments.

Appellants also pointed out that the examiner has refused to follow the Office's own guidebook. Responding to this, in the Examiner's Answer, the examiner argues that the MPEP is merely ambiguous about what is meant by "intent to broaden." However, the MPEP is far from ambiguous on this point. Specifically, the MPEP instructs:

[A] broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue application which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.

Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years. Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing (continuation or divisional) reissue application after the two year period.

MPEP § 1412.03(IV) (emphasis added). In this cited passage, the MPEP unambiguously states that an applicant can present a broadened claim after two years if "any intent to broaden" was presented within two years. The phrase "any intent" is simply not consistent with the examiner's alleged ambiguity. But the MPEP does not stop there. As if to anticipate the examiner's argument, the passage goes on to state that claims presented after two years may be presented "even though the broadened claim . . . is different." This cited passage then concludes by recognizing that it does not matter whether the later-broadened claims are presented in the first reissue or in a continuing reissue application. The MPEP is describing the specific situation in

this case. Accordingly, no reasonable interpretation of the MPEP supports the examiner's rejection.

The Examiner's Answer also misinterprets the Federal Circuit's decision in *In re Graff*, 111 F.3d 874, 877 (Fed. Cir. 1997). Appellants cited *Graff* for the general notion, consistent with the MPEP, that the law requires an applicant to put the public on notice of any intent to broaden — rather than a particular scope of broadening, as the examiner proposes. Nevertheless, relying entirely on *Graff*'s dicta, the examiner argues that *Graff* “seems to support the examiner's position.” The Examiner's Answer cites the following passage:

Mr. Graff proposes that it is sufficient if the public has notice that a reissue application had been filed within the two-year period, and that *Doll* charges the public with knowledge that broadening claims may be later added. On this case, the public had no notice that broadening was being sought until after the two-year period. We discern no justification for imposing this degree of uncertainty upon the public. The reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights.

Graff, 111 F.3d at 1473-74. But this does not support the examiner's position. In this passage, the court was distinguishing *Doll*, where notice of the intent to broaden existed but not the scope of broadening, with the facts in *Graff*, where “the public had no notice that broadening was being sought until after the two-year period” (emphasis added). Accordingly, *Graff* was concerned only with whether the public was on notice that broadening was being sought, not the scope of the broadening that was being sought. In this way, *Graff* is consistent with all of the other legal authority cited in this appeal, which does not require public notice of specific scope of broadening within the two-year period.

In the Examiner's Answer, the examiner also observes that 37 C.F.R. § 1.175, which governs reissue declarations, has been changed so that a reissue declaration no longer has to identify all errors that an applicant is seeking to correct. Rather, reissue declarations now need

to identify only one of the errors that an applicant seeks to correct through reissue. (Examiner's Answer, p. 11.) To the extent this observation is at all relevant to the issue in this appeal, it only further undercuts the examiner's rejection. By requiring an identification of only one error, the rules do not require that the public be put on notice of every "avenue of broadening" that the applicant may seek through reissue, contrary to the examiner's position.

Finally, the examiner argues that original reissue applications are unlike continuing reissue applications because they are published in the Official Gazette so that the public is given an opportunity to review the file to see the scope of the alleged errors. (Examiner's Answer, p. 13.) While this is true, it is noted that continuing reissue applications are also available for public review, including online via the Office's PAIR system. Moreover, when a continuing reissue application has been filed, the public is expressly notified in the published parent reissue patent. *See* 37 C.F.R. § 1.177(a) ("If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date."). Therefore, the examiner's concerns about the lack of notice for continuing reissue applications — in contrast to original reissue applications — rings somewhat hollow.

Second Reply Brief (filed January 12, 2009)

In the course of this appeal, the dispute between the appellants and the examiner has focused on whether the present continuation reissue application is required to address a "specific error" that was identified in the original reissue declaration filed within the two-year deadline. The appellants have already refuted that as a basis for rejecting the application, in both the

Appeal Brief and the previous Reply Brief, and those arguments will not be repeated here. But the examiner did raise a new issue in the Supplemental Examiner's Answer, which is addressed in this Reply. In particular, the examiner now argues that the continuation reissue application violates § 251 because it was "applied for" more than two years after the issue date of the original patent. (Supplemental Examiner's Answer, p. 4.) The new argument is equally unavailing.

The reissue statute provides that: "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." 35 U.S.C. § 251 (emphasis added). Quoting *In re Doll*, 419 F.2d 925, 164 U.S.P.Q. 218 (CCPA 1970), the examiner correctly points out that that "the language 'applied for' [in § 251] refers to the filing of an application." But then the examiner concludes that "the broadened claims were not presented in an application 'applied for' within two years of the issue date of the original patent." (Supplemental Examiner's Answer, p. 5.) This is a clear error, as it misunderstands fundamentally what a continuation application is.

A continuation application that satisfies the requirements of § 120 is entitled to the benefit of the filing date of the previously filed application to which it claims priority. 35 U.S.C. § 120. Specifically, the statute provides that a continuation application "shall have the same effect . . . as though filed on the date of the prior application." *Id.* The examiner has never argued that the continuation reissue application at issue in this appeal fails to satisfy the requirements of § 120. Therefore, there is no dispute that this application is entitled to the benefit of the filing date of the original reissue application and thus shall have "the same effect" as that application. Since the original application was filed within the two-year period, the

present continuation reissue application must be treated as having been filed, or “applied for,” within that two-year period.

In addition to the plain and unambiguous reading of the Patent Act, this conclusion is supported by prior cases as well as the examiner’s manual. For example, the Federal Circuit has explained that: “The statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met.” *In re Graff*, 111 F.3d 874, 876 (Fed. Cir. 1997). Moreover, the MPEP specifically addresses this issue: “Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing (continuation or divisional) reissue application after the two year period.” MPEP § 1412.03.

Because the parent reissue application was applied for within the two year period, the present continuation reissue application was also applied for within the two year period.

Lastly, the examiner concludes the Supplemental Examiner’s Answer by yet again erroneously comparing the facts in this appeal to the situation in *Ex parte Luu*, Appeal No. 96-1181, Application No. 08/188,764 (BPAI 1997); therefore, this will be addressed once more to clear the record. In *Luu*, the applicant filed a new reissue application one day before the first reissue application issued, and more than two years after the original patent grant. The Board held that the second reissue application was improper because (1) it was a new broadening reissue application filed more than two years from the original patent grant, and (2) it was an attempt to reissue another application before that application had actually issued in the first place. That situation is clearly inapposite because neither of those facts is true in this appeal. Moreover, the Board in that case suggested that the applicants’ mistake was to characterize the

second reissue as a reissue of the first reissue, rather than a continuation reissue application:

“Appellants are not seeking a second reissue of the original patent, but rather, are seeking a first reissue of the first reissue patent.” *Luu*, at 15. In other words, the Board was criticizing the applicants in *Luu* for not seeking what the applicants have sought in the present continuation reissue application — “a second reissue of the original patent.”

Claim 27

New claim 27 is added herein.

Suspension of Action

Applicants hereby request that action on the present application be suspended for a period of three months.

The examiner is invited to contact the undersigned in order to advance the prosecution of this case.

Respectfully submitted,

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